

**REMARKS**

The non-final Office Action dated September 5, 2008 has been carefully reviewed and the foregoing amendments and following remarks are made in response thereto.

The specification has been amended to incorporate essential material regarding the length and promoter activities of specific promoter fragments of SEQ ID NO: 113 from one of the present application's priority documents, U.S. Serial No. 60/425,087 filed on November 8, 2002, which is incorporated by referenced on page 1, lines 11-13 of the specification of the present application. Applicants have also amended the specification to incorporate by reference the sequence listing that is being submitted electronically herewith. The additional sequences included in this substitute sequence listing are derived from the aforementioned priority document, U.S. Serial No. 60/425,087 filed on November 8, 2002, which is incorporated by referenced on page 1, lines 11-13 of the specification of the present application. The figure numbers and the SEQ ID NOs. from the incorporated material have been amended to agree with the figure numbers and SEQ ID NOs. of the instant application. Figures 6-15, which correspond to Figures 1-10 in U.S. Serial No. 60/425,087, have been added to the instant application. All of above-described amendments have been made to comply with the Examiner's invitation to incorporate essential material from U.S. Serial No. 60/425,087 filed on November 8, 2002, which is incorporated by reference on page 1, lines 11-13 of the present specification. The material that has been added is the material that was incorporated by reference in the present application and no new matter has been added by way of these amendments.

In compliance with current EFS-Web practice (see "Legal Framework for EFS-Web" document signed November 29, 2007 by Deputy Commissioner for Patent Examination Policy John J. Love), the current electronic copy of the sequence listing complies with the requirements of 37 CFR 1.824, and therefore there is no submission of: i) any additional copies of the sequence listing pursuant to 37 CFR 1.821(e), nor ii) the statement described in 37 CFR 1.821(f). However, because the EFS is currently unavailable, Applicants are unable to file the sequence listing electronically and will file it on Monday, December 8, 2008 when EFS is again available.

Applicants acknowledge with appreciation the allowance of claim 1 and the objection to claim 21. Applicants further acknowledge the withdrawal of the rejections of Claims 7, 15, 16 and 18 under 35 U.S.C. § 112, second paragraph.

Claims 1-11 and 15-21 were pending in the application at the time the Office Action dated September 5, 2008 was issued. Claims 1-11 and 15-21 have been cancelled and new claims 22-39 have been added. New claim 24 corresponds to previously pending claim 1, which the Examiner had indicated was allowable. Thus, Applicants submit that new claim 24 is also allowable. New claims 22 and 25-36 correspond to previously pending claims 19, 3-11 and 15-17. New claim 23 finds support in previously pending claim 2 and the table in Example 3 at page 27, line 14 of the specification as well as SEQ ID NOs: 131-134. Example 3 and SEQ ID NOs: 131-134 have been inserted in the application by way of this amendment to incorporate material from U.S. Serial No. 60/425,087 filed on November 8, 2002, which was incorporated by reference in the present application. SEQ ID NOs: 131-134 are fragments of the promoter region of SEQ ID NO: 113 and correspond to nucleotides 1110-1643 (534 bp fragment); nucleotides 1159-1643 (485 bp fragment); nucleotides 1338-1643 (306 bp fragment); and nucleotides 1351-1643 (293 bp fragment), respectively. New claim 37 finds support in previously pending claim 20 and in the specification at page 15, lines 10-16. New claims 38 and 39 find support in previously pending claims 18 and 21.

Upon entry of this amendment, claims 22-39 will be pending in the application. Any canceled subject matter is made without prejudice or disclaimer for filing in one or more continuing applications. In view of the following remarks, Applicants respectfully request reconsideration and allowance of the pending claims.

#### **I. Rejections under 35 U.S.C. §112, 1<sup>st</sup> paragraph**

##### Claims 2-11, 15-17, and 20

Claims 2-11, 15-17, and 20 stand rejected under 35 U.S.C. § 112, first paragraph for allegedly failing to comply with the written description requirement. Although these claims have been cancelled, new claims 23 and 25-37 are directed to the same subject matter as claims 2-11, 15-17, and 20. With respect to previously pending claim 2, the Examiner states that this claim recites a functional vascular tissue specific *E. grandis* cOMT promoter that comprises fragments from SEQ ID NO: 12, SEQ ID NO: 60, nucleotides 1-1643 and nucleotides 1019-1643 of SEQ ID NO: 113. The Examiner alleges that the claimed genus of polynucleotide sequences encompasses a large number of sequences of various length and various structure (sequence) of the *E. grandis* cOMT gene. The Examiner further alleges that the specification only discloses

that the sequences from the 5'UTR of cOMT gene, particularly, a 1700 nucleotide fragment from SEQ ID NO: 113 and SEQ ID NO: 12, have the vascular tissue specific regulatory function. The Examiner alleges that the specification fails to disclose "what necessary element is required for the claimed function." The Examiner then concludes that the specification fails to disclose whether other fragments of SEQ ID NO:113 have the claimed vascular tissue specific regulatory function.

With regard to previously pending claims 4-11, 15-17 and 20, the claims are directed to a construct or a method of using a construct that comprises a promoter sequence as defined in claims 1 or 2. However, the Examiner states that claim 1 is directed to a polynucleotide sequence that comprises the entire sequence of SEQ ID NO: 113, which the Examiner alleges does not have the function of a vascular tissue specific *E. grandis* cOMT promoter.

The Examiner concludes that as a result of the alleged claimed broad genus and the alleged limited disclosure of the present specification, the Examiner finds that the description is allegedly not adequate to support the claimed genus.

The Examiner further offers guidance to cure the alleged lack of written description by properly incorporating the essential material from one of the present application's priority documents, U.S. Serial No. 60/425,087. Applicants have amended both the specification and the claims to properly incorporate the specific fragments of SEQ ID NO: 113 that are disclosed in this priority document.

However, Applicants submit that prior to this amendment of the present specification, the specification did provide an adequate written description for fragments of SEQ ID NO: 12, SEQ ID NO: 60, and SEQ ID NO: 113 that possess a functional vascular tissue specific *E. grandis* cOMT promoter activity. Applicants affirm that the written description requirement is satisfied when a patent specification describes the claimed invention in sufficient detail to convey to one skilled in the art that the inventor had possession of the claimed invention as of the application filing date (see MPEP 2163, Section I.) An applicant may show possession of the invention by disclosure of sufficiently detailed, relevant identifying characteristics, *i.e.*, complete or partial structure, other physical and/or chemical properties, functional characteristics when coupled with a known or disclosed correlation between function and structure, or some combination of such characteristics (MPEP 2163, Section II, A. 3a.). In the instant case, the specification discloses the complete structure (*e.g.* sequence) of the claimed polynucleotides and

methods for identifying promoter activities of any fragments of these polynucleotides without undue experimentation. Thus, Applicants submit that the written description has been met.

But in an effort to expedite prosecution, Applicants have complied with the Examiner's request that the present specification be amended to contain the alleged essential material from U.S. Serial No. 60/425,087. In view of the amendment to the specification and claims, it is requested that this rejection be withdrawn.

#### Claim 20

Claim 20 is rejected under 35 U.S.C. § 112, first paragraph for allegedly failing to comply with the written description requirement as the claim allegedly contains new matter. The Examiner states that the specification on page 15, lines 10-16 fails to support the language of claim 20. Claim 20 has been cancelled, but new claim 37 is directed to similar subject matter. In an effort to expedite the prosecution in the present application, Applicants have submitted new claim 37 that further defines the promoter sequence with regard to the plant tissue in which the DNA of interest is transcribed. In so far as the Examiner's rejection of previously pending claim 20 applies to new claim 37, it is believed that the language in new claim 37 has overcome the new matter rejection.

### **II. Rejection under 35 U.S.C. §112, 2<sup>nd</sup> paragraph**

#### Claim 18

Claim 18 is rejected under 35 U.S.C. § 112, second paragraph as being indefinite for the use of the word "recited." This word has been deleted from new claims 38 and 39 which correspond to the subject matter of previously pending claim 18. Thus, Applicants request withdrawal of this rejection.

### **III. Rejection under 35 U.S.C. §102**

#### Claim 18

Claim 18 is rejected as being anticipated by the sequence disclosed in Genbank Accession number AF168777 that allegedly comprises a 20-mer, a 40-mer, a 60-mer, a 80-mer, a 100-mer, a 120-mer, and 150-mer of SEQ ID NO: 113. Applicants note that the overlap between SEQ ID NO: 113 and the sequence disclosed in Genbank Accession number AF168777 is in the

coding region of the cOMT gene and not the promoter region. New claim 38 is directed to an isolated polynucleotide comprising different length “mers” of SEQ ID NO: 12, SEQ ID NO: 60, and nucleotides 1-1643 of SEQ ID NO: 113. Nucleotides 1-1643 comprise the promoter region and not the coding region of the cOMT gene and the sequence disclosed in Genbank Accession number AF168777 does not comprise a 20-mer, a 40-mer, *etc.* of nucleotides 1-1643 of SEQ ID NO: 113. Applicants note that SEQ ID NO: 12 has a priority date of March 25, 1999 and SEQ ID NO: 60 has a priority date of July 30, 1999 as described in Applicants’ response of March 1, 2007 (see pages 5 and 6 of the response). According to the Office Action dated December 1, 2006, the sequence in Genbank Accession number AF168777 was disclosed on August 19, 1999 (see page 6 of the Office Action dated December 1, 2006). Thus, in so far as the sequence in Genbank Accession number AF168777 contains any portion of the sequences in SEQ ID NO: 12 and SEQ ID NO: 60, the Genbank sequence is not available as prior art for these sequences.

New claim 39 is directed to an isolated polynucleotide comprising a 180-mer, a 220-mer, a 250-mer, a 300-mer, 400-mer, 500-mer or 600-mer of SEQ ID NO: 113. The sequence disclosed in Genbank Accession number AF168777 does not disclose any of the claimed polynucleotides. In view of the above remarks, Applicants respectfully request the rejection under §102(b) be withdrawn.

#### **IV. Objection to the Specification**

The specification is objected to for an attempt to incorporate essential material from U.S. Serial No. 60/425,087 that does not comply with 37 C.F.R. § 1.57 (b), (c) or (d). Because the incorporated material is relied upon to meet the rejection for inadequate written description noted above, Applicants have amended the specification and added new figures from U.S. Serial No. 60/425,087, one of the present application’s priority documents. No new matter has been added, and in view of addition of the information of additional fragments of SEQ ID NO: 113 that have vascular tissue specific *E. grandis* cOMT promoter activity to the specification, it is requested that this objection be withdrawn.

# CONCLUSION

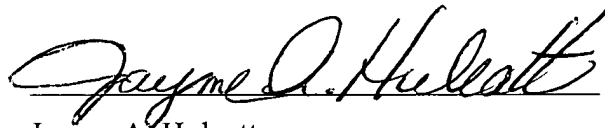
This reply is fully responsive to the Office Action dated September 5, 2008. In view of the above amendments and remarks, it is believed that the present set of claims are now in condition for allowance. If, in the opinion of the Examiner, a further telephonic conference would expedite any minor issues with regard to the pending claims, the Examiner is invited to call the undersigned practitioner.

Except for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-1283.

Respectfully submitted,

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